

The opinion in support of the decision being entered
today was not written for publication and
is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUN 16 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL C. WEAVER

Appeal No. 2006-1321
Application No. 09/838,866

ON BRIEF

Before FRANKFORT, OWENS and LEVY, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 41.50(a)(1) for appropriate action with regard to the items listed below.

In the final rejection mailed November 21, 2003 claims 1 through 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Eom et al. (U.S. Patent No. 5,344,608) in view of Weaver (U.S. Patent No. 5,573,607). The Notice of Appeal filed May 19, 2004 indicates appellant's intention to appeal from the examiner's final rejection of claims 1 through 16.

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However, in the brief filed July 19, 2004 appellant indicates on page 2 that "Claims 1 through 14 are being appealed" and specifically requests that "Claims 15 and 16 be withdrawn from further consideration."

Notwithstanding the foregoing, in the examiner's answer mailed October 7, 2004 the examiner continues to maintain the rejection of claims 1-16 under 35 U.S.C. § 103(a). Making no comment whatsoever regarding appellant's request that claims 15 and 16 be withdrawn from further consideration. In responses filed subsequent to the examiner's answer, it appears that appellant is again seeking allowance of claims 1 through 16 (see page 12 of the reply brief filed November 12, 2004 and pages 1 and 9 of the reply brief filed June 6, 2005). Thus, we are at somewhat of a loss concerning the actual status of claims 15 and 16 in the present application. Accordingly, we remand the application to the examiner to clarify the status of claims 15 and 16. It appears that the examiner, in response to the brief filed July 19, 2004, should have withdrawn claims 15 and 16 from further consideration and dismissed the appeal as to those claims.

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Another area of concern is the apparent failure of the examiner to specifically treat or otherwise comment on the declarations of Samuel C. Weaver filed on January 13, 2003 and August 21, 2003. Although the appellant repeatedly relies on the Weaver declarations to support arguments made in the brief and also in the reply briefs, the examiner has not once mentioned those declarations in the answer or provided any meaningful analysis and response for the facts and conclusions set forth therein. More particularly, we note that the examiner has not meaningfully responded to the arguments in the briefs and assertions in the declarations concerning the art recognized distinction between "metal alloys" and "metal matrix composite" materials, or appellant's assertions regarding unexpected and significant results achieved by the claimed invention. Therefore, we also remand for the examiner to fully treat the declarations.

As we indicated above, appellant has filed two reply briefs in the present application (November 12, 2004 and June 6, 2005). In each instance the examiner's response to the filing of the reply brief was to send a paper stating merely that the reply brief had been "noted." As set forth in 37 CFR § 41.43 in a proper response the primary examiner "must acknowledge receipt

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and entry" of the reply brief or pursue other actions noted in the rule. Since the examiner has not complied with the requirements of the rule, we remand for clarification concerning the status of the two reply briefs and a clear indication on the record as to whether the reply briefs were actually entered and considered. Moreover, we request that the examiner provide a response on the record to the arguments advanced by appellant in the reply briefs.

Another issue to consider on remand is whether the examiner's answer contains a new ground of rejection and therefore requires approval by a Technology Center (TC) Director or designee (MPEP § 1207.03). Regarding this aspect of the remand, we direct attention to the reply brief filed November 12, 2004 (page 10) and appellant's comment therein that a ground of rejection specifically disclaimed in the final rejection is now being maintained in the examiner's answer.

Assuming that a supplemental examiner's answer clarifying the issues discussed above will be necessary in response to this remand, it follows that appellant may exercise one of the options set forth in 37 CFR § 41.50(a)(2).

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This application, by virtue of its "special" status,
requires immediate action, see MPEP § 708.01 (item D), Eighth
Edition, Rev. 3, August 2005.

REMAND TO THE EXAMINER

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